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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/903,022	07/10/2001	Yuri Shtivelman	P3253C1	2846

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EXAMINER	
NGUYEN, STEVEN H D	

ART UNIT	PAPER NUMBER
2665	

DATE MAILED: 04/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/903,022	SHTIVELMAN ET AL.	
	Examiner	Art Unit	
	Steven HD Nguyen	2665	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *10 July 2001*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *2-17* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *2-17* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *7/10/01, 01/09/02*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 2-4, 6-8, 10-12 and 14-16 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 5 and 7-10 of U.S. Patent No. 6259692. Although the conflicting claims are not identical, they are not patentably distinct from each other because the application's claims merely broaden the scope of the patented claims by not claiming some elements (i.e port, status indicator, IP interface etc). The application's claims are nearly identical in every other respect to the patent claims. Therefore, the application's claims are simply broader versions of the patented claims. It is the examiner's position that broadening the patented claims by not claiming some of claim elements of the patented claims would have been obvious to one of ordinary skill in the art in view of the patented claims. It is important to note that the instant application is a continuation of the application that yielded the patent used herein as the basis for the obviousness type of double patenting rejection. The applicant is attempting to broaden the parent application's claims by eliminating some of the claim elements in the continuation at issue here. If allowed, the

application at bar would unjustly extend applicant patent protection beyond the statutory period while, at the same time, granting broader protection to the application. The patent and present application claims disclose a method and system for transmitting an alerting message to the subscriber that engaging with internet, in order to notify the subscriber an incoming call.

Regarding claims 5, 9, 13 and 17, The patent claims does not claim these limitation such drop internet connection before establishing a communication path. However, it is well known and expected in the art as disclosed by McMullin. Therefore, it would have been obvious to one of ordinary skill in the art to implement these function.

3. Claims 2-4, 6-8, 10-12 and 14-16 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7 of U.S. Patent No. 6078581. Although the conflicting claims are not identical, they are not patentably distinct from each other because the application's claims merely broaden the scope of the patented claims by not claiming some elements (i.e CTI server, local switch etc). The application's claims are nearly identical in every other respect to the patent claims. Therefore, the application's claims are simply broader versions of the patented claims. It is the examiner's position that broadening the patented claims by not claiming some of claim elements of the patented claims would have been obvious to one of ordinary skill in the art in view of the patented claims. It is important to note that the instant application is a continuation of the application that yielded the patent used herein as the basis for the obviousness type of double patenting rejection. The applicant is attempting to broaden the parent application's claims by eliminating some of the claim elements in the continuation at issue here. If allowed, the application at bar would unjustly extend applicant patent protection beyond the statutory period while, at the same time, granting broader

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Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 2-4, 6-8, 10-12 and 14-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Norris (USP 5805587).

Norris discloses an Internet call-waiting system comprising a service system which is PBX (Fig 2, Ref 38), connecting a user's personal computer (Fig 2, Ref 35) to the Internet (Fig 1, Ref 300) on a telephone line (Fig 1, Ref 10); and software at the service system for providing a call waiting service; wherein, in response to an indication at the service system of a call for the user on the same line, said service system generates an alter to the user's personal computer of

the arriving call (Fig 5, Ref 501-503, generating a alert message and transmitting the alert message to the subscriber computer).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 5, 9, 13 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Norris in view of McMullin (USP 5809128).

Norris fails to disclose the software includes a mechanism for responding to a disconnect by the user by causing the incoming call to be connected to the user via the telephone line. In the same field of endeavor, McMullin discloses the software includes a mechanism for responding to a disconnect by the user by causing the incoming call to be connected to the user via the telephone line (Col. 8, lines 5-12 and col. 11, lines 14-27).

Since, Norris suggests the options for receiving, redirecting. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to apply a method for redirecting the incoming call back to the subscriber line after the subscriber disconnected from the internet service provider as disclosed by McMullin's into the system and method of Norris. The motivation would have been to reduce the transmission delay and maintain a high quality for communication signal.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Foladare (USP 5982774) discloses a method and system for notifying the incoming call when the user engaging with Internet and suspending the data call by put them on hold by LEC and bridging the telephone lines for establishing a communication path.

Benson (USP 6104800) discloses a method and system for notifying the incoming call when the user engaging with Internet and suspending the data call by put them on hold and bridging the telephone lines for establishing a communication path by detecting a hook flash.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven HD Nguyen whose telephone number is (571) 272-3159. The examiner can normally be reached on 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Huy D Vu can be reached on (571) 272-3155. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Steven HD Nguyen
Primary Examiner
Art Unit 2665
3/24/05